AF JRW

Docket 83727JLT
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Mark Lelental, et al

COMPOSITION CONTAINING ELECTRONICALLY-CONDUCTIVE PARTICLES

Serial No. 10/036,126

Filed 26 December 2001

Group Art Unit: 1751

Examiner: Vijayakumar, Kallambella M

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Sherryl A. Payne

August 2, 2005
Date

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Sir:

REPLY BRIEF PURSUANT TO 37 C.F.R. 1.193

APPELLANTS' REPLY BRIEF ON APPEAL

Appellants have received and reviewed the Examiner's Answer mailed June 16, 2005. The following comments are presented in response to certain arguments in the Answer.

On page 7, the Answer states that Muys et al. and Gardner et al. teach the same hydrophilic latex polymers.

Appellants respectfully disagree. The latex polymers of Muys et al. are hydrophilic only because they include sulfonic acid or other hydrophilic functional groups (Col. 6, lines 14-36) such as a carboxylic acid group (Col. 7, lines 6-14 and Col. 12, lines 5-10) from itaconic acid or another ethylenically unsaturated carboxylic acid. The vinylidene chloride, methyl methacrylate (or other alkyl methacrylate) co-monomers have nothing to do with hydrophilicity. Appellants would request that the Examiner cite a textbook reference showing that those types of monomers are hydrophilic or provide hydrophilicity as suspended emulsion particles. The binders of Muys et al. are purposely designed with pendant hydrophilic groups irrespective of the other non-hydrophilic comonomers used therewith.

Gardner et al., on the other hand, truly provides a "laundry list" of various film-forming binders, many of which are clearly non-hydrophilic. In fact, the preferred binders are non-hydrophilic. If the Examiner disagrees, he is also requested to provide a state of the art teaching that the preferred film-forming poly(meth)acrylates (such as methyl methacrylate polymers), cellulose esters, polycarbonates, and polyvinyl formal binders are hydrophilic. Certainly, some of the binders in the longer list of Gardner et al. are hydrophilic, but where is the suggestion or motivation to pick them out from the dozens of possible non-hydrophilic binders? The Answer has failed to point it out. The only motivation that can be readily seen from Gardner et al. is clearly directed to the non-hydrophobic binders (Col. 15, lines 35-39).

Gelatin and gelatin derivatives are also listed in the lengthy list of binders in Gardner et al. If they are not buried, they are certainly not highlighted. They are listed with non-hydrophilic binders listed on either side, including those

incorporated from the cited references. Maybe if all of those possible binders had been listed, the entire column of the patent would have included binders and then maybe gelatin would be considered "buried". In effect, it is "buried" if every possible hydrophilic and non-hydrophilic binder is properly considered.

Even if we assume that a skilled artisan is directed to choose "hydrophilic binders" from the list in Gardner et al., which Appellants believe is untrue, which hydrophilic binders should be chosen among the dozens of possibilities? If Muys et al. is truly the guide as the Examiner's Answer alleges, a skilled artisan would not pick gelatin but would choose ionic polyesters and ionic acrylonitrile-vinylidene chloride polymers in Gardner et al. that are similar to the ionic latexes of Muys et al. Thus, hydrophilic latexes would be chosen, not gelatin. It's only the Examiner's hindsight look at Appellants' teaching that would suggest that gelatin would be chosen from the "laundry list" of binders, both hydrophilic and non-hydrophilic.

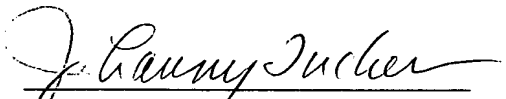
On pages 7 and 8, the Examiner's Answer appears to base its arguments of commonality of binders by citing U.S. Patents 6,025,119 (Majumdar et al.) and 5,312,681 (Muys et al.). Thus, it appears that the Examiner is trying to bolster the unpatentability rejection by citing two more references at this late stage of prosecution since there is a poor nexus between the different binders described in the originally cited Muys et al. and Gardner et al. patents. The proper way to handle this is to reopen prosecution for a full consideration of the issue and combined art.

With respect to the applicability of *Merck* and *Celeritas*, the teaching in Gardner et al. (even if the two additional cited references are considered also) fails to provide motivation to pick gelatin out of the dozens of possible ionic latexes and non-hydrophilic binders. The combined teaching does not "reasonably suggest to one having ordinary skill in the art" the use of a single non-preferred embodiment. It would require an extensive research program to arrive at one compound among so many for any reason, unless there is a hint towards choosing it. If gelatin is so obvious to use, why don't Muys et al. ('472) teach it instead of latex polymers? Why don't Gardner et al. teach that it is a preferred binder among both hydrophilic and non-hydrophilic possibilities? Why

doesn't either reference show the use of gelatin in an example? The answers to these questions logically lead to a conclusion that it is not obvious to use gelatin in the context of the presently claimed invention.

For the above reasons and those presented in their earlier Brief, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of Claims 1-12 and 17-19.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.